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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,494	12/08/2000	Michael C. Morrison	STL9-2000-0071US1/1855P	2391

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EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,494

Applicant(s)

MORRISON, MICHAEL C.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to presented arguments.

- Claims 1, 11, and 21 have been amended.
- Claims 1-30 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 5 January 2004 has been entered.

Response to Amendment

3. Applicant's arguments filed 5 January 2004 have been fully considered but they are not persuasive for the following reasons:

4. The prior rejections of the applicant's claims put forward by the examiner on the office actions mailed on 14 January 2003 and 17 October 2003 are maintained. The examiner has pointed out specific and selected parts of the prior art of record as directly related to the claim's language. The prior art of record clearly shows that a cookie with its associated information is maintained by the server and used to maintain a record of activities by the client as well as reestablishing the last activity in case of communication failure between server and client during the transaction (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65). To clarify both Kirsch and Luckenbaugh systems establish communication between a client and a server to retrieve certain

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information from a server, once this communication is established the server checks the client for existence of a cookie if such cookie exist the server compares the cookie with existing cookies in the storage at the server. Once the cookie has been verified depending on the last transaction the cookie has been related to the transaction will continue. By this mean the server does not need to start the transaction from the start in case of communication failure, but to start the transaction from the point that the communication failure occurs, once the communication is reestablished, utilizing the cookie and its associated information maintained by the server is used to achieve this out come of reestablishment of transaction at the point of failure. There is no need of manual intervention from the client user as the system presented by the prior art of record has presented.

5. As for the point of the contention that applicant has brought forth examiner has taken the position of that there has been no clear understanding of the term "a portion of..." and clarification of such has not been found within the specification. Therefore, it was interpreted that the "a portion of..." could be the all of the encryption key, which both Kirsch and Luckenbaugh clearly refer to as it has been clearly discussed above.

Claim Rejections - 35 USC §101

6. ☐ Claims 1, 11, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

7. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claim 1 only recites an

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abstract idea. The recited steps of merely obtaining a first value and a second value and performing a mathematical analysis to determine if they are the same or not does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of continuing a transaction.

8. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention it only continues the transaction based on a comparison of two values (i.e., useful and tangible).

9. Therefore, claims 2-10, 12-20, and 22-30 as being dependent on the above independent claims are rejected.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

11. The term "a portion of..." in claims 1, 11, and 21 is a relative term, which renders the claim indefinite. The term "a portion of..." is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. The use of "a portion of..." phrase makes the claims indefinite and unclear in that neither means nor interrelationship of means nor method steps are set forth in the claims in order to achieve the desired results expressed in the "a portion of..." phrase.

12. Also the independent claims 1, 11, and 21 recite "initiating a transaction..." phrase making the claims indefinite and unclear in that neither means nor interrelationship of means nor method steps are set forth in the claims in order to achieve the desired results expressed in the 'initiating a transaction...' phrase.

13. Therefore, claims 2-10, 12-20, and 22-30 as being dependent on the above independent claims are rejected.

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Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-5, 11-15, and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,963,915 to Steven T. Kirsch or U.S Patent No. 6,311,269 to Gary L. Luckenbaugh et al.

As per claims 1, 11, and 21, Kirsch and Luckenbaugh clearly disclose, a method, system, and computer readable medium for conducting a transaction over a network, the network including a first system and a second system, the method, system, and program instructions comprising the steps of:

- a) initiating a transaction session;
- b) comparing a value of the first system with a value of the second system, wherein the value of the first system comprises a portion of an encryption key is associated with particular transaction session; and
- c) continuing the transaction based on the comparison (See Kirsch abstract, figure 3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65,. To clarify both Kirsch and Luckenbaugh systems establish communication between a client and a server to retrieve certain information from a server, once this communication is established the server checks the client for existence of a cookie if such cookie exist the server compares the cookie with existing cookies in the storage at the server. Once the cookie has been verified depending on the last transaction the cooki has been related to the transaction will continue.)

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As per claims 2, 12, and 22, Kirsch and Luckenbaugh clearly disclose, all the limitations of claims 1, 11, and 21, further;

Kirsch and Luckenbaugh clearly disclose,

- the first system comprises a client system and the second system comprises a server system (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65).

As per claims 3, 13, and 23, Kirsch and Luckenbaugh clearly disclose, all the limitations of claims 2, 12, and 22, further;

Kirsch and Luckenbaugh clearly disclose,

- the value of the client system is in a persistent client side data file (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65).

As per claims 4, 14, and 24, Kirsch and Luckenbaugh clearly disclose, all the limitations of claims 3, 13, and 23, further;

Kirsch and Luckenbaugh clearly disclose,

- the persistent client-side data file comprises a cookie (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65).

As per claims 5, 15, and 25, Kirsch clearly discloses all the limitations of claims 4, 14, and 24, further;

Kirsch and Luckenbaugh clearly disclose,

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- b1) allowing the server system to compare the value in the cookie with the value in the server system (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65).

16. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-10, 16-20, and 16-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 5,963,915 to Steven T. Kirsch or U.S Patent No. 6,311,269 to Gary L. Luckenbaugh et al. as applied to claims above, and further in view of U.S. Patent No. 5,991,399 to Gary L. Grauke et al.

As per claims 6, 16, and 26, Kirsch and Luckenbaugh disclose all the limitations of claims 5, 15, and 25, further;

Grauke clearly teaches,

if the value in the cookie does not match the value in the server system, step c) further comprises:

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- c1) generating an encryption key;
- c2) storing a portion of the encryption key in the cookie; and
- c3) storing the entire encryption key on the server system (See Grauke bstract, figures 2, 4A and 4B and associated text, column3, lines 5-20 and 60-68, column 6, lines 17-35, column 7, lines 8-68, and column 8, lines 1-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kirsch and Luckenbaugh and Grauke to achieve a greatly increased protection and control of downloads of data files by encrypting them and tracking the download process.

As per claims 7, 17, and 27, Kirsch and Luckenbaugh disclose all the limitations of claims 6, 16, and 26, further;

Grauke clearly teaches, that step c) further comprises:

- c4) allowing the server system to transfer encrypted information to the client system; and
- c5) allowing the server system to transfer a remaining portion of the encryption key to the client system whereby the encryption key is capable of being utilized by the client system to decrypt the encrypted information (See Grauke abstract, figures 2, 4A and 4B and associated text, column3, lines 5-20 and 60-68, column 6, lines 17-35, column 7, lines 8-68, and column 8, lines 1-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kirsch and Luckenbaugh and Grauke to achieve a greatly increased protection and control of downloads of data files by encrypting them and tracking the download process based on an specific key for that particular data file payment.

As per claims 8, 18, and 28, Kirsch and Luckenbaugh disclose all the limitations of claims 7, 17, and 27, further;

Grauke clearly teaches,

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- step c5) is performed in response to a payment transaction from the client system to the server system (See Grauke abstract, figures 2, 4A and 4B and associated text, column3, lines 5-20 and 60-68, column 6, lines 17-35, column 7, lines 8-68, and column 8, lines 1-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kirsch and Luckenbaugh and Grauke to achieve a greatly increased protection and control of downloads of data files by encrypting them and tracking the download process based on an specific key for that particular data file payment.

As per claims 9, 19, and 29, Kirsch and Luckenbaugh disclose all the limitations of claims 5, 15, and 25, further;

Grauke clearly teaches, if the value in the cookie does match the value in the server system, ABC discloses that step c) further comprises:

- c1) allowing the server system to transfer encrypted information to the client system; and
- c2) allowing the server system to transfer a remaining portion of the encryption key to the client system whereby the encryption key is capable of being utilized by the client system to decrypt the encrypted information (See Grauke abstract, figures 2, 4A and 4B and associated text, column3, lines 5-20 and 60-68, column 6, lines 17-35, column 7, lines 8-68, and column 8, lines 1-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kirsch and Luckenbaugh and Grauke to achieve a greatly increased protection and control of downloads of data files by encrypting them and tracking the download process based on an specific key for that particular data file payment.

As per claims 10, 20, and 30, Kirsch and Luckenbaugh disclose all the limitations of claims 9, 19, and 29, further;

Grauke clearly teaches,

- step c2) is performed in response to a payment transaction from the client system to the server system(See Grauke abstract, figures 2, 4A and 4B and associated text, column3, lines 5-20 and 60-68, column 6, lines 17-35, column 7, lines 8-68, and column 8, lines 1-31).

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18. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kirsch and Luckenbaugh and Grauke to achieve a greatly increased protection and control of downloads of data files by encrypting them and tracking the download process based on an specific key for that particular data file payment.

19. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to:


(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K
January 22, 2004**


**JAMES P. TRAMMELL
SUPERVISOR OF THE EXAMINER
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